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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,738	03/10/2004	Andrew Schwartz	04-13259	6420
25189	7590	07/26/2007		
CISLO & THOMAS, LLP 233 WILSHIRE BLVD SUITE 900 SANTA MONICA, CA 90401-1211			EXAMINER HYLINSKI, ALYSSA MARIE	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/798,738	<b>Applicant(s)</b> SCHWARTZ, ANDREW	
	<b>Examiner</b> Alyssa M. Hylinski	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-59 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 38-43, 46 and 48-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrie (6186505) and Drouhard (6520502). Perrie discloses a method of playing a game by beginning the game on a starting non-absorbent point (column 11 lined 26-28 and column 12 lines 13-14) that is near at least one other non-absorbent point (column 11 Table V) of a multi-dimensional game board (Fig. 1) having a plurality of non-absorbent points surrounded by a plurality of absorbent points (column 11 Table V and column 12 lines 9-24). The starting position, for example space 1 yellow can be a randomly chosen non-absorbent point that is located with at least two other non-absorbent points such as RR and 2 yellow in a row that is bounded by a first absorbent point such as 3 red if it completes the red set (column 10 lines 66-67) and a second absorbent point such as the "Go to Jail" space (column 10 lines 61-67). A player can place at least one wager that a first absorbent point will be chosen before a second absorbent point (column 8 lines 21-66 and column 9 lines 1-23). The player observes an event such as a computer operated random number generator (column 8 lines 45-48) or the rolling of dice that will dictate to the player which point has been chosen (column 11 lines 25-26). It is then determined whether the point is a non-

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absorbent point, a first absorbent point, or a second absorbent point with the game continuing if the point is a non-absorbent point (column 10 lines 64-67). The player is awarded the at least one wager if the point is a first absorbent point such as a completed color group and is denied the at least one wager if the point is a second absorbent point such as the "Go To Jail" space (column 10 lines 40-67). The game includes multiple first and second absorbent points (column 12 lines 9-24) and a player's winnings can be calculated in regard to the player's wager to pay a certain amount at the end of the game (column 10 Table IV) if the point chosen is a non-absorbent point (column 12 lines 14-17). The starting non-absorbent point can become a first or second absorbent point after the first move of the game if other points in the set also become selected (column 10 lines 65-66). The game must be started on a non-absorbent point however there are several possible non-absorbent points on the board (column 11 lines 26-28 and column 12 lines 13-14) therefore several possible starting positions are provided. A plurality of non-absorbent points such as the RR spaces, are oriented in a north, south, east, and west orientation (column 11 Table V). A player can wager on a plurality of first and second absorbent points (column 10 Table IV and column 12 lines 9-24). The wager can include a place bet or a wager that the game-piece will enter one or more given states prior to entering other states (column 6 lines 28-33). The first absorbent point corresponds to a safe or winning point (column 12 lines 19-20) and a second absorbent point corresponds to a sink or losing point (column 10 lines 59-60). The game includes a game board with one or more player stations having one or more betting areas (Fig. 2). Perrie discloses the basic inventive

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concept, substantially as claimed, with the exception of a game piece being moved about the play board to the various points thereon. Drouhard discloses a wagering game using a play board that has a marker or game piece (42) that is movable about the board (Fig. 1) based on the rolling of dice (column 3 lines 11-17). A player continues to move his or her piece around the board until an end situation is reached making the game inherently capable of allowing a player's piece to occupy a space or point previously occupied (column 3 lines 11-60). It would have been obvious to one of ordinary skill in the art from the teaching of Drouhard to move a game piece about the game board in response to the dice rolls of Perrie in order to create an interesting game by taking a classic board game and making it usable for casino play (column 1 lines 15-36) as well as to help a player follow the movement of the game about the board. Although, Drouhard does not expressly state that the same space can be occupied more than once it does disclose that the game pieces continue to travel around a continuous game board until an end of the game, thereby allowing the spaces to be occupied more than once. The examiner notes that it is proper to take into account not only specific teachings of a reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *See in re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

3. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrie, Drouhard and Piper (5135231). Perrie and Drouhard disclose the basic inventive concept, substantially as claimed, with the exception of the observed event including dice such that half the faces on a first die move the game piece in a first direction and

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the other half of the faces move the game piece in an opposite direction and a half the faces on a second die move the game piece in third and fourth opposite directions, respectively. Piper discloses a board game having the points of the board oriented in a north, south, east and west orientation and uses two dice having indicia thereon for moving the game pieces in a first direction such as north, a second opposite direction such as south, a third direction such as west and a fourth opposite direction such as east (Figs. 1 & 2). It would have been obvious to one of ordinary skill in the art from the teaching of Piper to set up a board game such that a game piece could be moved in a multitude of directions about a board based on rolling dice in order to make the game more exciting by having a variety of different paths over which the game piece can be moved as opposed to just circling around the periphery of a game board in one direction. In regard to the limitation of the first and second directions located on the first die and the third and fourth directions located on the second die, the examiner notes that a mere rearrangement of parts that would not effect the operation of the device would be entirely obvious. *See in re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)*. Therefore, it would have been an obvious matter of design choice to modify the first die with just the north and south directions and the second die with the east and west directions since changing which die the elements were does not alter how the die would operate when rolled.

4. Claims 45 and 46 rejected under 35 U.S.C. 103(a) as being unpatentable over Perrie, Drouhard, Piper and further in view of Cambardella (4070026). The method of Perrie, Drouhard and Piper discloses the basic inventive concept, substantially as

claimed, with the exception of the first direction being oblique to the third direction and the points being oriented in a northwest, northeast, southwest and southeast orientation. Cambardella discloses a board game utilizing a die for determining the movement of a game piece in oblique directions as compared to the first and second north and south directions (Figs. 2 & 3) and a game board that has points oriented in northwest, northeast, southwest and southeast orientations (Fig. 1). It would have been obvious to one of ordinary skill in the art from the teaching of Cambardella to set up the game board and dice in this way in order to be able to move the game pieces in a multitude of directions about a board based on rolling dice in order to make the game more exciting by having a variety of different paths over which the game piece can be moved as opposed to just circling around the periphery of a game board in one direction.

5. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrie and Drouhard. The references disclose the basic inventive concept, substantially as claimed, with the exception of the play board having one or more absorbent points interspersed among non-absorbent points in predetermined locations in addition to a plurality of absorbent points that surround the non-absorbent points. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have absorbent points surrounding non-absorbent points because Applicant has not disclosed that having absorbent points surrounding non-absorbent points provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected

Applicant's invention to perform equally well with a plurality of absorbent and non-absorbent points situated about the board because it still creates an interesting and entertaining game.

### ***Response to Arguments***

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Drouhard is used to teach the use of game pieces with game boards suitable for casino play in response to the roll of dice. Drouhard shows how using game pieces to traverse a game surface in response to the roll of dice in casino games is a functional equivalent to the lighted markers of Perrie.

7. In response to applicant's argument that the disclosure of Perrie is not disposed to the addition of a game piece, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).



***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH



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